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Joerg Beringer

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EXAMINER

JAMI, HARES

ART UNIT

PAPER NUMBER

2169

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/658,584

Applicant(s)

BERINGER ET AL.

Examiner

Hares Jami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 25-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 02/23/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This is in response to the applicant election filed on 22 March 2007. Claims 1-20, and 25-36 were elected. Claims 21-24 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claims, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 22 March 2007.

Applicant's election with traverse of group I (claims 1-20 and 25-36) in the reply filed on 03/22/2007 is acknowledged. The traversal is on the ground(s) that the examiner has not asserted or demonstrated that there is a serious burden in examination of all the claims at once. This is not found persuasive because as mentioned in the previous office action the claims are grouped to two different subclasses (claim 1-20 and 25-36 drawn to 707/03 and claims 21-24 drawn to 707/102). Each subclass has utility by itself and does not need the other combination. The group I and II are two distinct inventions, the group I (claims 1-20 and 25-36) is a method of searching, and the group II (claims 21-24) is a system for generating a data structure, which are two. Therefore, there is a serious burden on examiner has to search these to groups of claims separately. Moreover, the Applicant under USC 101 can apply for one invention in each application. The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 02/23/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objection

Claims 5 and 30 recites the limitation "data connectors" in line 2. There is insufficient antecedent basis for this limitation in the specification or drawing.

There is a typo in claim 8. The claim ends with two periods ("statically.."). The correction is requested.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-36 are rejected under 35 U.S.C. 101.

Regarding claims 25-36,

the Applicant describes that the term "machine-readable medium" refers to any computer program product ([0063], lines 4-5). Therefore, the claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they

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fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Further more, claims 25-36 are rejected under 35 U.S.C. 101 for failing to place the invention squarely within one statutory class of invention. On page19, paragraph [0063], lines 7-10 of the instant specification, applicant has provided evidence that applicant intends the "medium" to include signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a

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process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition of matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 and 25-36 are rejected under 35 U.S.C. 112, second paragraph.

Regarding claim 1,

Claim 1 recites the limitation "the desired attributes" in lines 8 and 9. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 2,

Claim 2 recites the limitation "the attribute" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Moreover, the phrase "a user interface" (line 4) renders the claim indefinite because it is not clear to one of ordinary skill in the art whether it is the same "user interface" receiving characteristics of a resource in claim 1 (line 2), or it is a new "user interface".

Regarding claims 4, 16, 18, and 28,

The phrase "can be" (claim 4, line 2); (claim 18, line 1), (claim 28, line 3) and term "can" (claim 16, line 2) render the claims indefinite because "can be" / "can" does not impart functionality to the claims making the occurring of the claims limitations

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conditional. If the conditions are satisfied then the limitations of the claims occur.

However, the Applicant does not disclose what happens if the conditions are not satisfied.

Regarding claim 14,

Claim 14 recites the limitation "wherein receiving attributes" in line 1. There is insufficient antecedent basis for this limitation in claim 1. Claim 1 does not have the limitation of "receiving attributes".

Regarding claims 25-28, 31, 33-34, and 36,

The term "operable" (line 1) in the claims does not positively recite the subject matter that applicant regards as his/her invention. The term "operable" suggests that the method claims are capable of implementing the limitations of the claims and the limitations of the claims may or may not occur. Therefore, claims 25-28, 31, 33-34, and 36 are rejected under 112, second paragraph.

Regarding claim 26,

the phrase "a user interface" (line 5) renders the claim indefinite because it is not clear to one of ordinary skill in the art whether it is the same "user interface" receiving characteristics of a resource in claim 25 (line 3), or it is a new "user interface".

Regarding claims 3-19, 29-30,32, and 35,

claims 3-19, 29-30,32, and 35 depend on the rejected claims 1 and 25.

Therefore, claims 3-19, 29-30,32, and 35 are rejected at least based on the same rational.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5, 7-13, 19-20, 25-31, and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert, US Patent 5,721,906 (patent date: Feb. 24, 1998) in view of Singh et al. ('Singh', hereafter), US Publication US 2003/0130994 A1 (filed on Sep. 26, 2002).

Regarding claim 1,

Siefert discloses a method comprising:

- receiving characteristics of a resource desired by a user through a user interface (Siefert discloses a user interface that search words or characteristics of a desired resource are inputted, see Fig. 9 and col. 10, lines 44-46);

- searching a data source of resource profiles associated with each of a plurality of resources for profiles having one or more of the characteristics (Siefert discloses that the profiles of resources are searched to locate the resource of interest, which has the characteristics desired by the user, see Col. 4, lines 31-33);
- providing a hit-list of resources having the one or more desired characteristics (Siefert discloses a hit-list of resources that has the desired characteristic of Unix, see Fig. 11);

Siefert discloses the above limitations of claim 1. However, Siefert is silent with respect to receiving additional characteristics of the resource through a refinement user interface, searching the hit-list for the desired attributes; and providing a narrowed hit-list of resources matching the desired attributes. On the other hand, Singh discloses a method, system and software for retrieving information bases on front and back matter data, which is form the same field of endeavor of retrieving information ([0006], Singh). Singh teaches the technique of further narrowing the result pages by providing the user with specific search criteria and instructing to narrow the search parameters ([0079] and [0204], lines 5-8, Singh). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made having the teachings of Siefert and Singh before him/her to modify the method of searching resource profiles of Siefert with Singh system. A skilled artisan would have been motivated to incorporate the technique of narrowing down the result pages of Singh with the method of searching resource profiles of Siefert in order to receive additional characteristics of the resource through a

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refinement user interface, search the hit-list for the desired attributes; and provide a narrowed hit-list of resources matching the desired attributes. A good motivation for doing so would have been reducing the number of selected non-relevant resources with increasing the chance of selected relevant resources.

Regarding claim 2,

the combination of Siefert in view of Singh teaches segmenting the hit-list by grouping the resources by one of the attribute dimensions (Siefert teaches grouping the resources according to fixed categories, [see col. 12, lines 25-29 and Fig. 19, Siefert]; moreover, Singh discloses that the search results screen display a summary segmenting the results by groups of titles, authors, and publishers and showing the statistics of each group which corresponds to attribute dimension limitation, see [0155]-[0158], Singh), and displaying statistics associated with the segment (Singh discloses displaying the statistics associated with segments on the hit-list; Singh gives examples such as number of authors, number of tiles, and number of publications which are statistics with each segment of authors or publishers, see [0156]-[0160] and [0287], Singh); Receiving a selection of one or more segments through a user interface; and Providing a narrowed hit-list by selecting one or more resources from the selected segments (the combination of Siefert in view of Singh teaches the limitation of receiving the selections of segments of resources [categories of resources] that user can select [see Fig. 19, Siefert], and narrowing the hit-list by selecting a range of a group [see [0163], Singh], which is corresponds to providing a narrowed hit-list by selecting one or more resources from the selected segments).

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Regarding claim 3,

the combination of Siefert in view of Singh further teaches maintaining a list of resources associated with a hit inspected by the user (Singh discloses retaining [i.e., maintaining] some of retrieved information based on an indication by the user [see [0019], Singh]); Displaying a history of search and refinement dialogs including a list of resources previously displayed (Singh discloses that Search History selection is provided [i.e., displayed] on the screen of Search Selection, see [102], lines 1-2, Singh) ; Back navigating to a state within the search history by displaying the corresponding hit-list; and displaying the list of inspected resources as the hit-list, (Singh further discloses a Search History saves [i.e., maintaining] a list of search criteria associated with a hit as cookies on the computer that has been done by the user ; the step of accessing the last 20 searches conducted by the user corresponds to the claimed limitation of, allowing the user to navigate back through the previous searches [see [0102] and [0276], Singh]).

Regarding claim 4,

the combination of Siefert in view of Singh further discloses providing the hit-list as a collection of items that can be used for further actions or stored as a persistent collection, (Siefert discloses that the user is provided with a collections of hit-list which can be used for further action of retrieving , see Fig. 11-13, and Col. 11, lines 10-15).

Regarding claim 5,

the combination of Siefert in view of Singh further discloses that the resource profiles are defined by facets, attributes, and data connectors (Siefert discloses that a

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profile contains descriptive information [i.e., attributes] characterizing resources, like title, product ID, cost, price, and resource description [see col. 4, lines 29-30 and Fig. 48], which corresponds to definition of facet by the Applicant describing facets as set of attributes[see [0020], lines 67, instant application]).

Regarding claim 7,

the combination of Siefert in view of Singh further discloses associating the narrowed hit-list into a collection of resources, (this limitation is equivalently taught when Singh discloses retaining some of retrieved information across query session [i.e., a hit-list of resources] on an indication by the user, which associates the retrieved information [can be a narrowed hit list of resources] with the already saved information [i.e., collection of resources], see [0019], Singh).

Regarding claim 8,

the combination of Siefert in view of Singh further discloses the collection of resources is stored dynamically or statically, (Singh equivalently discloses the limitation of storing dynamically of resources by teaching that the search criteria [i.e., query] is saved as a cookie [see [0276], Singh], which correspond to the Applicant's description of storing dynamically as storing the query [see [0010], lines 4-5, instant application]; Singh further teaches the limitations of storing statically of resources by teaching that the retrieved information is retained [i.e., saved] by the user indication [see [0019], Singh], which correspond to the Applicant's description of storing statically as storing the hit-list [see [0010], lines 4-5, instant application]).

Regarding claims 9-10,

the combination of Siefert in view of Singh further discloses aggregating the narrowed hit-list with an existing collection of resources and the existing collection of resources comprises an historical listing of aggregated narrowed hit-lists (Singh equivalently teaches the limitation of aggregating the narrowed hit list to the collection of historical aggregated narrowed hit-lists when he discloses that search results page contains the option of "saving in user file/profile" [see [0287] and [0295], Singh], which saves the results [i.e., selected resources] in a file which can contain other saved results forming an aggregated collection of results. Singh further discloses merging found materials or retrieved information with material selected during earlier searches, see [0509], lines 5-10, Singh).

Regarding claim 11,

the combination of Siefert in view of Singh further discloses segmenting the narrowed hit-list by discrete values of an attribute dimension, (Siefert teaches grouping [i.e., segmenting] the resources according to fixed categories [see col. 12, lines 25-29 and Fig. 19, Siefert]; moreover, Singh discloses that the search results screen display a summary segmenting the results by groups of titles, authors, and publishers and showing the statistics of each group which corresponds to attribute dimension limitation, see [0155]-[0158], Singh).

Regarding claim 12,

the combination of Siefert in view of Singh further discloses comprising providing one or more descriptive statistics associated with the segment, (Singh discloses

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providing statistical data for the groups of results such as number of titles, or number of authors meet the criteria which forms a group, see [0155]-[0160] and [0287]; Singh);

Regarding claim 13,

the combination of Siefert in view of Singh further discloses the hit-list is refined to resources associated with a particular descriptive statistic, (Singh discloses refining the search results by selecting the range of authors or specific authors, see [0163], which the statistics data already about authors already provided on the results page, see [0155]-[0157], Singh).

Regarding claim 19,

the combination of Siefert in view of Singh further discloses the hit-list is used to create a community, (Singh discloses that retrieved information or found materials [i.e., hit-list] can be merged with materials that found earlier, and user can share their resources with other users through collaborative tools, which forms a community, see [0509], Singh).

Regarding claim 20,

the combination of Siefert in view of Singh further discloses enabling communication with resources in the community, (Singh discloses collaborative tools that enable the communication of resources in the community, see [0509], lines 10-14, Singh).

Regarding claims 25-31, and 33-36,

the scope of claims 25-31, and 33-36 are substantially the same as claims 1-4, 10, 5, 12, 6-7, and 9-11, respectively. Therefore, claims 25-31, and 33-36 are rejected

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on the same basis as set forth for the rejections of claims 1-4, 10, 5, 12, 6-7, and 9-11, respectively.

Claims 14-16, 18, 6, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert, US Patent 5,721,906 (patent date: Feb. 24, 1998) in view of Singh et al., US Publication US 2003/0130994 A1 (filed on Sep. 26, 2002), and further in view of Coiera et al. ('Coiera', hereafter), US Publication 2005/0086204 A1 (PCT filed on Nov. 20, 2002).

Regarding claim 14,

the combination of Siefert in view of Singh discloses all the limitations of claim 1. However, it is silent with respect to receiving a search template by the user. On the other hand, Coiera discloses a system and method for searching data sources, which is from the same field of endeavor of searching data (see Abstract and [004], Coiera). Coiera teaches the technique of selecting a search template according to search parameters by the user (see [0004], lines 5-11, Coiera). Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made having the teachings of the combination of Siefert in view of Singh to further modify the combination of Siefert in view of Singh system with Coiera teaching. A skilled artisan would have been motivated to incorporate the technique of selecting a search template according to search parameters by the user as taught by Coiera (see [0004], lines 5-11, Coiera) with the method of searching profiles of resources of the combination of Siefert in view of Singh in order to receive a search template from the user. As Coiera teaches

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a motivation for doing so would have been to reduce time, effort and skill for novice user to search data sources in most effective way (see [0006], Coiera).

Regarding claim 15,

the combination of Siefert in view of Singh and further in view of Coiera teaches the search template is defined by the user, (Coiera discloses that the user can create [i.e., define] his search template by saving his Advance Search, see [0061] and [0008], Coiera).

Regarding claim 16,

the combination of Siefert in view of Singh and further in view of Coiera teaches the search template comprises a multi-resource query that can return resources of more than one resource type, (Coiera discloses that query using for the template searching more than one resource type, see Table 1 in [00090], queries are included different type of data sources).

Regarding claim 18,

the combination of Siefert in view of Singh and further in view of Coiera teaches the search template can be saved and reused, (Coiera discloses storing the template on the user's system and using them by the creator, see [0085], lines 7-9, Coiera).

Regarding claim 6,

the combination of Siefert in view of Singh and further in view of Coiera teaches a pattern-based user interface of a search tool is generated from the resource profile, (Coiera equivalently teaches this limitation by disclosing that a the Advanced Searched can be saved as a search template based on the search criteria and search keywords

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[see [0061], Coiera], as it is well known in the art a search template is a pattern-based user interface which is generated based on the desired keywords of the user to search for data source which can be a resource profile).

Regarding claim 32,

the scope of claim 32 is substantially the same as claim 6. Therefore, claim 32 is rejected on the same basis as set forth for the rejection of claim 6.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Siefert, US Patent 5,721,906 (patent date: Feb. 24, 1998) in view of Singh et al., US Publication US 2003/0130994 A1 (filed on Sep. 26, 2002), and further in view of Coiera et al., US Publication 2005/0086204 A1 (PCT filed on Nov. 20, 2002), and further in view of Nardozzi et al. ('Nardozzi', hereafter), US Patent 6,636,837 B1 (patent date: Oct. 21, 2003 filed on Jan. 27, 2000).

Regarding claim 17,

the combination of Siefert in view of Singh and further in view of Coiera teaches all the limitation of claim 14. However, it is silent with respect the search template is auto-configured based on the resource type, attributes or facets. On the other hand, Nardozzi teaches the technique of allowing the automatic customizing of the screen for the user based on the past history or personal information of the user (see col. 7, lines 8-15, Nardozzi). Nardozzi and the combination of Siefert in view of Singh and further in view of Coiera are from the same field of endeavor of displaying information. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was

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made having the teachings of Nardozzi to modify the combination of Siefert in view of Singh and further in view of Coiera with Nardozzi system. A skilled artisan would have been motivated to incorporated the technique of allowing the automatic customizing of the screen for the user based on the past history or personal information of the user (see col. 7, lines 8-15, Nardozzi) with search template of the combination of Siefert in view of Singh and further in view of Coiera in order to auto-customized (i.e., auto-configured) the search template based on the resource type because it facilitates the searching based on the user preferences resulting in saving time for the user.

Conclusion

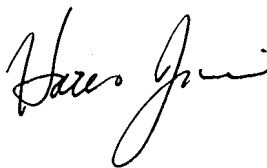
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hares Jami whose telephone number is 571-270-1291. The examiner can normally be reached on Mon to Fri 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chase can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hares Jami
Examiner
Art Unit 2169



HJ
04/18/2007



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